

REMARKS

I. STATUS OF THE CLAIMS

This Amendment and Response (hereinafter, the “Amendment”) is submitted in response to the non-final Office Action dated April 27, 2010 (hereinafter, the “Office Action”). Claims 1-25 are pending in the application. Claims 1, 14, 17 and 23 are in independent form.

By this Amendment, as outlined above, claims 3, 16 and 23 have been amended either (1) for form, (2) to address the 35 U.S.C. § 112, second paragraph (hereinafter, “Section 112”) rejection, or (3) to clarify certain aspects of the filler-type reservoir. Examples of where support for the claim amendments can be found in the originally-filed application include paragraph [0067].

It is believed that no new matter has been added. The claim amendments made herein do not represent acquiescence in the Examiner’s rejections, but rather are made only to expedite prosecution of the present application. Applicants expressly reserve the right to pursue the subject matter of any previously presented or canceled claims in one or more continuation applications.

Following entry of this Amendment, claims 1-25 remain pending in the application.

II. THE CLAIM REJECTION UNDER 35 U.S.C. § 112

In paragraphs 2 and 3 of the Office Action, claim 16 is rejected under Section 112 as allegedly being indefinite for failing to particularly point out and distinctly claim subject matter which Applicants regard as the invention. The Examiner asserts that there is insufficient antecedent basis for the limitation “said outer barrel.” (*Office Action*, ¶¶ 2-3.) In response, as outlined above, “said outer barrel” has been revised to recite “an outer barrel.”

Accordingly, in view of the above amendment, Applicants respectfully request that the Section 112 rejection be withdrawn.

III. THE CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b)

In paragraph 4 of the Office Action, claims 1-13 and 17-23 are rejected under 35 U.S.C. § 102(b) (hereinafter, “Section 102(b)”) as allegedly being anticipated by U.S. Patent No. 5,026,189 to Keil (hereinafter, “Keil”). In addition, also in paragraph 4 of the Office Action, claims 14-16 are rejected under Section 102(b) as allegedly being anticipated

by U.S. Patent Application Publication No. 2004/0161282 to Bolton (hereinafter, "Bolton").
The rejections are traversed for at least the following reasons.

A. Claims 1-13 And 17-23 Are Patentable Over Keil

Independent claim 1 is directed to a writing instrument comprising, *inter alia*, "an inner writing element having a first writing tip and a first writing medium reservoir; and an outer writing element having a second writing tip and a second writing medium reservoir," wherein "*said inner writing element and said outer writing element are axially moveable with respect to each other.*" As disclosed in paragraph [0029] of the originally-filed application, in one embodiment of the present writing instrument, "both writing elements 20, 22 may be moveable from a position with a respective writing tip substantially entirely within outer barrel 12 to a position with a respective writing tip outside outer barrel 12." (*Originally-Filed Application*, ¶ [0029].) In addition, the present application discloses, "as shown by arrow 26, writing elements 20, 22 are capable of axial movement with respect to each other." (*Id.* at ¶ [0030].) Applicants respectfully submit that Keil fails to disclose or suggest such a writing instrument.

In paragraph 4 of the Office Action, the Examiner asserts that Keil discloses a writing instrument having "an inner writing element (48, 49, 44b; see Fig. 7)" and "an outer writing element (47, 44a)." (*Office Action*, ¶ 4.) The Examiner also asserts that "said inner writing element and said outer writing element are axially moveable with respect to each other" and cites column 4, lines 54-68 of Keil in support of this assertion. (*Id.*) However, upon a closer reading of Keil, Applicants respectfully submit that the inner writing tip 49 is stationary and is therefore, not axially moveable. For example, Keil discloses, "[t]his writing material reservoir tampon 44a has an inner bore open at the insert 51 in which an outer large-diameter writing tip 47 can slide to a limited extent axially." (*Keil*, col. 4, lines 54-56.) Keil also discloses, "[t]he outer writing tip 47 is supported by a holding sleeve 46 which engages with several axially inwardly projecting extensions 46a rotationally and axially displaceably into the open end of the insert 51." (*Id.* at col. 4, lines 58-62.) Lastly, Keil discloses, "[o]n rotation the holding sleeve 46 is displaced axially with the large-diameter outer writing tip 47. It can thus be advanced with respect to the stationary inner writing tip 46 into a writing

position or retracted with respect to the same into a nonuse position.” (*Id.* at col. 4, line 65 to col. 5, line 1.)

Based on a review of the remaining disclosure in Keil (see, for example, column 3, line 51 to column 4, line 6 in which holding sleeve 6, large-diameter writing tip 7 and small diameter writing tip 9 correspond to holding sleeve 46, large-diameter outer writing tip 47 and writing element 49, respectively) and Figure 7, it appears that the recitation “the stationary inner writing tip 46” in column 4, line 67-68 includes an error and should instead recite that “the stationary inner writing tip” is element 49. Because, as disclosed in Keil, element 46 is the “holding sleeve,” (see column 4, lines 59 and 65), the inner writing tip cannot be element 46 and instead, must be element 49 as depicted in Figure 7. To read this section any other way, does not make sense because the holding sleeve and the inner writing tip cannot be the same element. Thus, because the inner writing tip 49 is stationary, the inner writing element 49 and outer writing element 47 in Keil are not “axially moveable with respect to each other.”

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” (M.P.E.P. § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed Cir. 1987))). Accordingly, because, as discussed above, the sections of Keil relied upon by the Examiner at least do not provide for a writing instrument having inner and outer writing elements where “said inner writing element and said outer writing element are axially moveable with respect to each other,” the Section 102(b) rejection must fail as a matter of law. Therefore, Applicants submit that claim 1 is not anticipated by Keil and respectfully request that the Section 102(b) rejection be withdrawn.

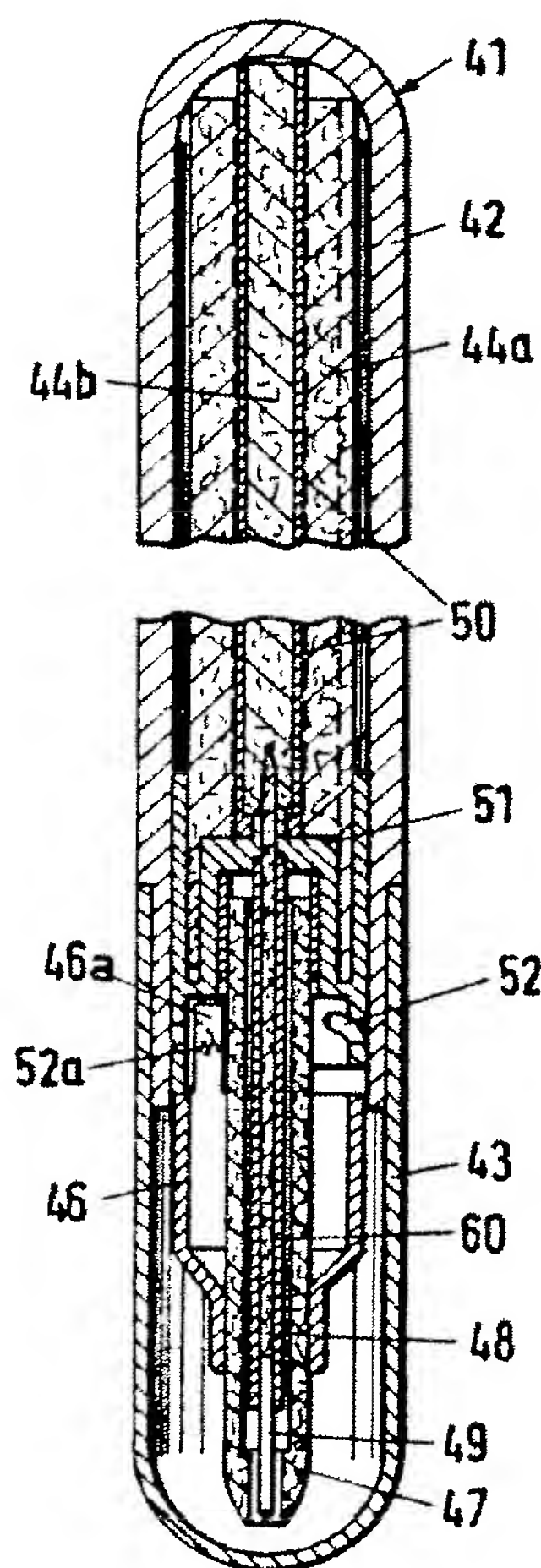
For at least the foregoing reasons, it is believed that independent claim 1 is patentable over Keil. Independent claim 17 includes similar recitations to those discussed above for claim 1 and is therefore allowable for similar or somewhat similar reasons to those discussed for claim 1. Further, claims 2-13, which depend from claim 1, and claims 18-22, which depend from claim 17, are believed to be allowable as well.

Moreover, revised independent claim 23 is directed to a filler-type instrument comprising, *inter alia*, “a filler-type reservoir” and “a writing tip coupled to said filler-type reservoir,” wherein “said filler-type reservoir has a non-porous element covering at least a

portion of said writing tip and also covering at least a portion of an outer surface of said filler-type reservoir . . . said non-porous element acting as a coupling to join said writing tip and said filler-type reservoir together.” Applicants respectfully submit that Keil fails to disclose or suggest such an instrument.

In paragraph 4 of the Office Action, the Examiner asserts that Keil discloses a filler-type instrument that includes a filler-type reservoir with “a non-porous element (50) covering at least a portion of an outer surface of said filler type reservoir.” (*Office Action*, ¶ 4.) As disclosed in Keil, “[t]he two writing material reservoir tampons 44a and 44b are separated from each other by a tube 50.” (*Keil*, col. 4, lines 19-22.) As can be seen in Figure 7 from Keil, which is reproduced below, tube 50 does not couple the reservoir tampons 44a and 44b to their respective writing tips 47, 49.

Fig.7



Accordingly, Applicants submit that claim 23 is not anticipated by Keil and respectfully request that the Section 102(b) rejection be withdrawn.

For at least the foregoing reasons, it is believed that independent claim 23 is patentable over Keil.

B. Claims 14-16 Are Patentable Over Bolton

Independent claim 14 is directed to a writing instrument comprising, *inter alia*, an inner writing element having a first writing tip and a first writing medium reservoir and an outer writing element having a second writing tip and a second writing medium reservoir, wherein “said inner and outer writing elements are axially moveable with respect to each other.” Applicants respectfully submit that Bolton fails to disclose or suggest such a writing instrument.

In paragraph 5 of the Office Action, the Examiner asserts that Bolton discloses a writing instrument having “an inner writing element having a first writing tip (25; see Fig. 7 and 9)” and “an outer writing element having a second writing tip (43).” (*Office Action*, ¶ 5.) The Examiner also asserts that Bolton discloses that “said inner and outer writing elements are axially moveable with respect to each other” and cites paragraph [0059] of Bolton in support. (*Id.*) However, in paragraph [0059], Bolton only states that “the position of the nib 25 can be changed simply by moving the socket 42 relative to the socket 41.” (*Bolton*, ¶ [0059].) Thus, Bolton fails to disclose or even suggest that the second writing tip 43 is axially moveable. Accordingly, because the sections of Bolton relied upon by the Examiner at least do not provide for a writing instrument having inner and outer writing elements where “said inner and outer writing elements are axially moveable with respect to each other,” the Section 102(b) rejection must fail as a matter of law. Therefore, Applicants submit that claim 14 is not anticipated by Bolton and respectfully request that the Section 102(b) rejection be withdrawn.

For at least the foregoing reasons, it is believed that independent claim 14 is patentable over Bolton. Further, claims 15 and 16, which depend from claim 14, are believed to be allowable as well.

V. THE CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)

In paragraph 7 of the Office Action, claims 9 and 10 are rejected under 35 U.S.C. § 103(a) (hereinafter, “Section 103(a)”) as allegedly being unpatentable over Keil. Additionally, in paragraph 8 of the Office Action, claim 24 is rejected under Section 103(a) as allegedly being unpatentable over Keil in view of U.S. Patent No. 6,561,713 to Sukhna, *et al.* (hereinafter, “Sukhna”). The rejections are traversed for at least the following reasons.

A. Claims 9 And 10 Are Patentable Over Keil

Claims 9 and 10 depend from independent claim 1, which was shown in Section II(A) above to be patentable over Keil. In particular, Keil fails to disclose or suggest a writing instrument having an inner writing element and an outer writing element wherein “said inner writing element and said outer writing element are axially moveable with respect to each other.

Accordingly, for at least the foregoing reasons, it is believed that claims 9 and 10 are patentable over Keil and are therefore allowable. Thus, Applicants respectfully request that the Section 103(a) rejection be withdrawn.

B. Claim 24 Is Patentable Over Keil In View of Sukhna

Claim 24 depends from independent claim 23, which was shown in Section II(A) above to be patentable over Keil. In particular, Keil fails to disclose or suggest a writing instrument having an inner writing element and an outer writing element wherein “said inner writing element and said outer writing element are axially moveable with respect to each other. Further, Applicants respectfully submit that Sukhna fails to cure the deficiencies of Keil.

Accordingly, for at least the foregoing reasons, it is believed that claim 24 is patentable over Keil and Sukhna, either taken alone or in combination, and is therefore allowable. Thus, Applicants respectfully request that the Section 103(a) rejection be withdrawn.

VI. NONSTATUTORY OBVIOUSNESS-TYPE DOUBLE PATENTING

In paragraph 10 of the Office Action, claims 1-25 are rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims

U.S. Application No.: 10/706,315
Attorney. Docket No.: 5367-039-999
Response to Office Action dated April 27, 2010

1-13, 18-20, 23 and 26 of U.S. Patent No. 7,147,392 to Bedhome, *et al.* In response, Applicants respectfully request that the double patenting rejection be held in abeyance until one or more of the pending claims have been found allowable.

In addition, Applicants' representative would like to note that U.S. Patent No. 7,147,392 is currently going through reissue. The reissue application no. is 12/334,178.

CONCLUSION

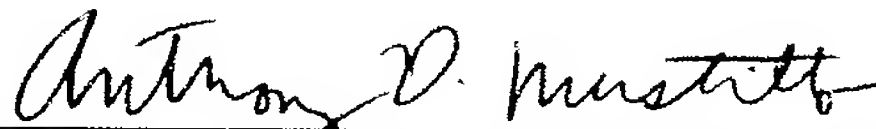
In view of the above remarks, Applicants respectfully request that the Examiner reconsider pending claims 1-25 with a view towards allowance.

The Examiner is invited to call the undersigned attorney at (212) 326-3939 if a telephone call could help resolve any remaining issues.

Should any fees be required, please charge such fees to Jones Day Deposit Account No. 50-3013.

Date: July 27, 2010

Respectfully submitted,



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